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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/205,419 06/10/88 CABILLY

S 100/150C1

EXAMINER

NISBET, T

ART UNIT

PAPER NUMBER

185

DATE MAILED:

09/07/90

MAX D. HENSLEY
GENENTECH, INC.
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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 6/10/88 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 68-100 are pending in the application.

Of the above, claims 87-100 are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 68-86 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

PTOL-326 (Rev. _____)

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 67-86, drawn to a method of producing immunoglobulins and the associated vectors and host cells, classified in Class 435, subclass 69.1.

II. Claims 87-100, drawn to a separate, patently distinct method of producing an immunoglobulin, classified in Class 435, subclass 69.1.

Inventions Group I and Group II are distinct and independent of each other and as such, will support separate patents. The method of Group I is drawn to immunoglobulin chains which are independently expressed in the transformed host cell while the method of the second Group does not make this distinction. Further, Group I refers to the antibody fragment composed of both heavy and light chain variable regions whereas Group II refers to a fragment composed of the either the heavy or light chains with variable and constant regions present in each chain.

In response to a telephone message from Max Hensley on August 30, 1990, a provisional election was made without traverse to prosecute the invention of Group I, corresponding to claims 67-86. Affirmation of this election must be made by applicant in responding to this Office action. Claims 87-100 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

Examiner wishes to acknowledge receipt of two facsimile transfers from the applicants pursuant to telephone conversations on the August 17, 1990 and August 24, 1990. Unfortunately, the facsimile transfer failed to comply with requirements of 1096 OG 30 with respect to proper certification of fax transfer and so cannot be entered into the official record. As a result the only official claims pending are claims 67-100 and of the pending claims, only claim 87 is proper.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

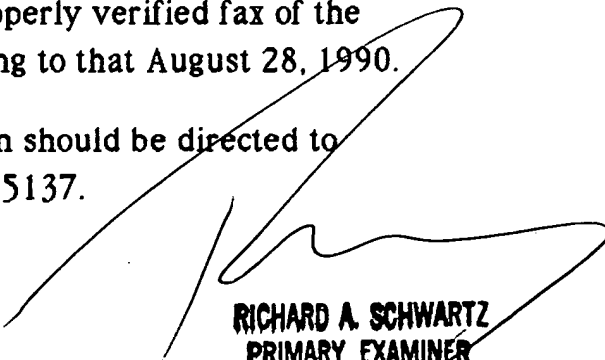
"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

Claims 68-86 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are rejected as being improperly dependent. All of the above claims depend on claim 67 which was cancelled in the first supplemental amendment.

Claims 88-100 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Except for claim 87, all of the claims depend on previously cancelled claims 53, 58, 59, or 66.

These rejections will be obviated by a properly verified fax of the second supplementary amendment corresponding to that August 28, 1990.

An inquiry concerning this communication should be directed to Examiner Nisbet at telephone number 703-557-5137.



RICHARD A. SCHWARTZ
PRIMARY EXAMINER
ART UNIT 121/85